

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:

Redmond et al.

Application No.: 09/090,067

Filed: June 3, 1998

For: IDENTIFICATION DOCUMENT WITH
DOCUMENT SPECIFIC REDUCED
SCALE PRINTING

Examiner: M. Henderson

Date: September 28, 2004

Art Unit 3722

Confirmation No.: 3497

CERTIFICATE OF MAILING

I hereby certify that this paper and the documents referred to as being attached or enclosed herewith are being deposited with the United States Postal Service on September 28, 2004 as First Class Mail in an envelope addressed to: Mail Stop APPEAL BRIEF – PATENTS, COMMISSIONER FOR PATENTS, P.O. Box 1450, Alexandria, VA 22313-1450.

Joel R. Meyer
Attorney for Applicant

TRANSMITTAL LETTER

MAIL STOP APPEAL BRIEF – PATENTS
COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, VA 22313-1450

Enclosed for filing in the above-captioned matter is the following:

- ☒ Reply Brief
- ☒ Please charge any fees which may be required in connection with filing this document and any extension of time fee, or credit any overpayment, to Deposit Account No. 50-2535.

Date: September 28, 2004

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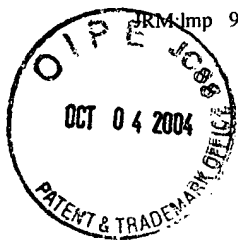
Phone: 503-885-9699
FAX 503-885-9880

Respectfully submitted,

DIGIMARC CORPORATION

Joel R. Meyer
Registration No. 37,677

Appell



JRM-lmp 9/28/04 P0540D

PATENT

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Joel R. Meyer
Attorney for Applicant

REPLY BRIEF

Mail Stop APPEAL BRIEF
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Sir:

In response to section 2 of the Examiner's Answer, Appellant confirms that there are no related appeals or interferences as expressly stated on page 3 of Appellant's brief.

In response to section 11 of the Answer providing a response to Appellant's argument, Appellant reiterates the following points.

First, the Office has failed to establish that the cited art teaches or suggests several elements of the claims. For example, the Office has failed to establish that the cited art teaches the light/dark tone printed text as recited in claims 4 and 5 and the tone differences as recited in claims 24 and 25.

As another example, the Office has failed to establish that the cited art teaches the use of an encrypted form as recited in claim 18.

Second, as outlined in Appellant's brief, the Office relies on a combination of disparate teachings of the UK patent, Dow and Richardson to render the claims obvious. In order to form the novel combination of elements in the claims, one of ordinary skill in the art would have to modify the teachings of the UK patent, Dow, and Richardson, and then combine the modified teachings to obtain the claimed invention. This approach of modifying and then combining the teachings can only be done with impermissible hindsight in view of the Appellant's novel combination, and therefore, is improper.

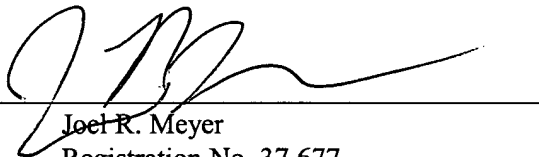
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Registration No. 37,677